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PATENT APPLICATION
Attorney's Do. No. 4164-125

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of: John F. Acres

Serial No. 09/558,933

Examiner: Harrison, Jessica

Filed: April 26, 2000

Group Art Unit: 3714

For: ELECTRONIC GAMING MACHINE WITH LOYALTY BONUS DISPLAY

Confirmation No. 1655

TRANSMITTAL LETTER

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Enclosed for filing in the above-referenced application are the following:

- ☒ Appeal Brief in triplicate
- ☒ Filing Fee
- ☒ PTO Form 2038 authorizing credit card payment for the above-listed fees
- ☒ Any deficiency or overpayment should be charged or credited to deposit account number 13-1703. A duplicate copy of this sheet is enclosed.

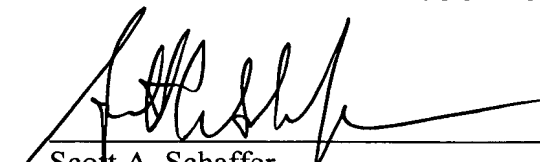
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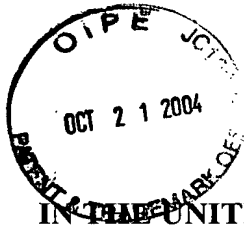

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**APPELLANT'S BRIEF
UNDER 37 C.F.R. § 1.192**

Appeal is taken from the Examiner's Office Action dated May 17, 2004, finally rejecting claims 1-21 in this application.

This Appeal Brief is further to the Notice of Appeal mailed in this case on August 17, 2004.

The fees required under §1.17(c) are dealt with in the accompanying Transmittal of Appeal Brief.

This Brief is transmitted in triplicate.

This Brief contains these items under the following headings, and in the order set forth below.

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Jessica Steinberg

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I. REAL PARTY IN INTEREST 37 C.F.R. § 1.192(c)(1)

The real party in interest is as named in the caption of this Brief (the inventor) and the assignee of the present application, Acres Gaming, Inc.

II. RELATED APPEALS AND INTERFERENCES 37 C.F.R. § 1.192(c)(2)

There are no other appeals or interferences known to Appellant, the Appellant's representative, or assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS 37 C.F.R. § 1.192(c)(3)

Status Of All The Claims:

- 1. Claims presented: 1-21
- 2. Claims withdrawn from consideration but not cancelled: NONE
- 3. Claims canceled: NONE
- 4. Claims pending: 1-21, of which:
 - a. claims allowed: NONE
 - b. claims rejected: 1-21

All the rejected claims, namely claims 1-21, are being appealed. The appealed claims are eligible for appeal, having been finally rejected.

IV. STATUS OF AMENDMENTS **37 CFR §1.192(c) (4)**

Subsequent to the last Office Action mailed on May 17, 2004, which contained a Final Rejection of the appealed claims, no amendment has been filed.

V. SUMMARY OF THE INVENTION **37 CFR §1.192(c) (5)**

This invention outlines a solution for displaying loyalty award information on the main display of a gaming machine in conjunction with the game. The gaming machine includes gaming electronics for projecting a game image onto a gaming machine display associated with the gaming machine. The gaming machine is coupled over a network to a host computer that keeps track of data corresponding to a casino patron such as loyalty bonus information, player ID, and so forth ("player tracking data"). The player tracking data is transmitted from the host computer to a gaming machine responsive to identification of the casino patron operating the machine, as via an electronic card reader. The player tracking data is received by a machine communication interface within the gaming machine and is further processed for display by a video overlay device that combines the game image with the player account display information. Accordingly, both the game (e.g. slot machine) and the player account information can appear on the same display monitor.

VI. ISSUES ON APPEAL **37 CFR §1.192(c) (6)**

Claims 1, 2 and 4-6 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Heidel (EP 0769769), in view of Found, et al. (PCT 97/12315).

Claims 3 and 7-11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Heidel in view of Found as applied to claim 1 above and further in view of Fertitta, III, et al. (U.S. Patent No. 6,302,793).

Claims 12-16 stand rejected under 35 U.S.C. §102(b) as being anticipated by Heidel.

Claims 17-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Heidel in view of Fertitta, III, et al.

The general issue is whether claims 1-21 are unpatentable under 35 U.S.C. §§ 102(b) and 103(a) in view of the prior art of record. Briefly, the specific issues can be stated as follows:

- (1) Is a video overlay device structure implied within the Heidel reference when, instead, the combined image is generated in the first instance?

- (2) Can the Found reference be properly combined with the Heidel reference despite the fact that no player tracking system is contemplated in Found and the resulting information displayed using Found would be common (rather than personalized) to each machine on the network?
- (3) Does the Heidel reference allow a retrofit of existing machines without replacing electronics as the presently claimed invention would allow? If not, then a §102(b) rejection would be clearly inappropriate.
- (4) Does the Heidel reference teach the existence of supplemental commands for combining game images with player tracking images?

VII. GROUPING OF CLAIMS

37 CFR §1.192(c) (7)

The claims are grouped into three sets: (1) claims 1-11 claiming a method for displaying player account information using first electronics to generate the first (game) image and second electronics to generate player account information for display in an OVERLAY image, (2) independent claim 12 claiming an apparatus for displaying additional information on a gaming machine display using supplemental commands to combine a game image with supplemental information, and (3) claims 13-21 claiming an apparatus for displaying information on a display including a video overlay device for simultaneously displaying player tracking information with game images on the same display.

Each independent claim are directed to different aspects of the invention and each stand and fall, independently, with their associated dependent claims.

VIII. ARGUMENT

37 CFR §1.192(c) (8)

First a comment on the main thrust of the invention. The casino industry includes many thousands of pre-existing gaming machines with only limited capabilities, where each machine includes gaming electronics responsible for generating game information and driving such information for display on a video monitor. Additionally, the gaming industry has very strict rules governing the addition of electronics to gaming machines, particularly those that modify the base wagering game of the machine. This is an especially sensitive area when customers buy the basic gaming machines from one vendor, and want to add additional functionality using additional equipment bought from a second vendor.

The present invention is intended to allow additional functionality to be easily added to gaming machines so that additional information can be added to the same display without

completely replacing the gaming electronics of the original game. We believe that the Examiner is misunderstanding the purpose or function of the invention as expressed by the following claim elements:

- Claim 1 – the step of “combining the original image with the overlay image to create a combined image.”
- Claim 12 – the “communication means” which is “operative with said gaming electronics to combine said game image with a player tracking image.”
- Claim 13 –the “video overlay device” which is “interposed between the gaming electronics and game video display to overlay the player tracking data received from the host computer on top of the game image received from the gaming electronics.”

Turning next to an analysis of the prior art of record, the key cited patent is the Heidel patent owned by Ballys Gaming International, which the Examiner reads as teaching the idea of using a video overlay device to present player tracking data on the main display of the gaming machine. Applicant disagrees with this characterization on the grounds that Heidel does not disclose a video overlay device but simply teaches generating a display image in the first instance that includes player tracking data and the game image. In other words, Heidel could not be used to retrofit existing gaming machines without completely replacing the gaming machine display controller. In the current invention, only a supplemental controller board need be added and the original gaming display controller need not know of the existence of the supplemental board.

The claims in the patent are directed to a method and apparatus for displaying player account information on the main display of the gaming machine as opposed to on a separate video fluorescent display (VFD). Briefly, the invention contemplates generating an original game image, and overlaying a second image (e.g. a player account image) on the original image thus resulting in a combined image. It is this combined image that is displayed on the main gaming machine display.

The Examiner points to the video controller 56 shown in FIG. 2 of Heidel and described on col. 5, lines 17-21. However, we can find no such mention of a video overlay device specifically and, in fact, claim 15 (col. 9, lines 9-16) recites to a video display having control means that comprise a game memory and a control memory for displaying a game, where the game includes game control touch areas. This claim does not seem to indicate that a video game image is created, and then an overlay image is created, and that the images are combined. Rather, the claim seems to indicate that a complete image is generated in the first instance. It was not known in the industry to use a video overlay device, and to applicant’s

knowledge Ballys never used such a device. There is only one video controller (element 56) disclosed; the touch screen controller 60 only operates to interpret presses positions on the touch screen and does not itself create an image.

Accordingly, rejection of the claims on the basis of the Heidel patent would be improper because Heidel does not, *inter alia*, teach the steps of or include structure for:

Claim 1:

generating in first display electronics game display information to create an original image;

generating in second display electronics player account display information to create an overlay image; and

combining the original image with the overlay image to create a combined image.

Claim 12:

said communication means including supplemental commands operative with said gaming electronics to combine said game image with a player tracking image

Claim 13:

a video overlay device interposed between said gaming electronics and said game video display to overlay the player tracking data received from the host computer on top of the game image received from the gaming electronics.

Turning next to the Found patent (WO97/12315), the disclosure appears to include a video overlay device (e.g. video mixing device 42) used to superimpose network jackpot information on the normal EGM display. The Found patent does not, however, teach interfacing the gaming machine with a player tracking system. Accordingly, any information displayed on the Found gaming display would be common to all EGMs on the network. That is, the same jackpot information is displayed on each gaming machine.

In contrast with the Found disclosure, the present invention displays information unique to the player on the gaming machine display that results from communications between the EGM and player tracking system identifying the player. Accordingly, jackpot data and player tracking data are incomparable and the claims should be allowable.

Care must be given when combining references in an argument that such combination would be obvious to one skilled in the art to teach the features, functions, and methods of the claimed invention. The Federal Circuit has been consistent in reversing the PTO when a rejection is made on the basis of hindsight, that is when an Examiner rejects the application under 35 U.S.C. §103(a) grounds as obvious under a combination of two or more patents without any specific suggestion within the patents to combine the features. In re Rouffett, 47

USPQ2d 1453 (Fed. Cir. 1998), the Federal Circuit refused to uphold an obviousness rejection, even where skill in the art is high, absent the specific identification of principal, known to one of ordinary skill in the art that suggests the claimed combination.

The Federal Circuit reemphasized the care to be taken when combining prior art references in obviousness findings in Ecolchem v. Southern Cal. Edison, 56 USPQ2d 1065 (Fed. Cir. 2000), stating that such absence of evidence to combine prior art references “is defective as hindsight analysis.” The Federal Circuit held similarly in In re Kotzab, 55 USPQ2d 1313 (Fed. Cir. 2000), reversing the PTO and stating that, “[i]dentification of prior art statements that, in abstract, appear to suggest claimed limitation does not establish prima facie case of obviousness without finding as to specific understanding or principal within knowledge of skilled artisan that would have motivated one with no knowledge of the invention to make the combination in the manner claimed.”

Finally, the Federal Circuit has reaffirmed their view that the PTO used improper hindsight analysis to reject patent claims under §103(a) in the recent case of In re Lee, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002), stating that a specific suggestion in the prior art cited is required and not a simple citation to “common knowledge and common sense.” Lee includes a tour-de-force of case law directed to the issue of combining references including those as follows:

- “The factual inquiry whether to combine references must be thorough and searching. . . It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.” (Lee, 277 F.3d at 1343)
- “A showing of a suggestion, teaching, or motivation to combine the prior art references is an essential component of an obviousness holding.” (*quoting* Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000)
- “Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” (*quoting* C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)
- “There must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant.” (*quoting* In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998)

- “Teachings of references can be combined *only* if there is some suggestion or incentive to do so.” (quoting In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (emphasis in original))

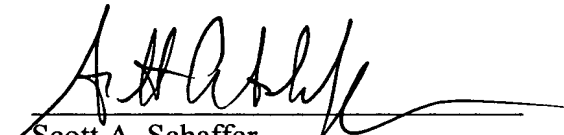
The Patent Office has failed to display the rigor required by the Federal Circuit holdings in demonstrating a suggestion within the art that the cited prior art references should be combined.

CONCLUSION

For the foregoing reasons, Appellant requests that the Board reverse the Examiner's rejections to Appellant's claims.

Respectfully submitted,

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IX. APPENDIX
37 CFR §1.192(c) (9)

The text of the claims on appeal, 1-21 are as follows:

1. A method for displaying player account information on a display of a gaming device connected by a network to a host computer comprising:
creating a player account accessible by the host computer;
generating in first display electronics game display information to create an original image;
accessing at the gaming device the player account from the host computer;
generating in second display electronics player account display information to create an overlay image;
combining the original image with the overlay image to create a combined image; and
displaying the combined image on the display of the gaming device.
2. The method of claim 1 wherein the step of combining the original image with the overlay image includes the step of overlaying the overlay image on top of the original image.
3. The method of claim 2, further including:
dividing the display into a plurality of display fields including at least a game display field and a player tracking display field; and
displaying the original image within the game display field and the overlay image within the player tracking display field.
4. The method of claim 1, wherein the player account display information includes a player name.
5. The method of claim 1, wherein the player account display information includes a player ID.
6. The method of claim 1, wherein the player account display information includes a player point total.

7. The method of claim 1, wherein the player account display information includes a session point total.

8. The method of claim 1, wherein the player account display information includes a personal progressive.

9. The method of claim 1, wherein the player account display information includes an extra credit.

10. The method of claim 1, wherein the player account display information includes a loyalty bonus.

11. The method of claim 1, wherein the player account display information includes a loyalty award.

12. An apparatus for displaying additional information on a gaming machine display comprising:

a host computer including a database of player tracking information;

a gaming machine coupled to said host computer over a network, said gaming machine including a gaming machine display and gaming electronics for generating and projecting a game image onto the gaming machine display; and

communication means for bi-directional communication between the host computer and the gaming machine, said communication means including supplemental commands operative with said gaming electronics to combine said game image with a player tracking image generated from said player tracking information communicated from said host computer to said gaming machine.

13. An apparatus for displaying information on a display of one of a plurality of gaming machines coupled over a network to a host computer comprising:

a card reader operable with a casino-issued player tracking card to identify a user of the gaming machine;

a machine communication interface coupled to receive player tracking data from a host computer responsive to a user identified from the card reader;

a game video display;

gaming electronics programmed to operate and display a game image on the game video display; and

a video overlay device interposed between said gaming electronics and said game video display to overlay the player tracking data received from the host computer on top of the game image received from the gaming electronics.

14. The apparatus of claim 13, wherein the player tracking data includes a player name.

15. The apparatus of claim 13, wherein the player tracking data includes a player ID.

16. The apparatus of claim 13, wherein the player tracking data includes a player point total.

17. The apparatus of claim 13, wherein the player tracking data includes a session point total.

18. The apparatus of claim 13, wherein the player tracking data includes a personal progressive.

19. The apparatus of claim 13, wherein the player tracking data includes an extra credit.

20. The apparatus of claim 13, wherein the player tracking data includes a loyalty bonus.

21. The apparatus of claim 13, wherein the player tracking data includes a loyalty award.